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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/636,700	08/07/01	SENDER	DER-117001

320587 HMI2/6907
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EXAMINER
PATTON, P

ART UNIT	PAPER NUMBER
1651	

DATE MAILED: 08/07/01

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/636,185

Applicant(s)

Gerber et al.

Examiner

Patricia Patten

Art Unit

1651



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on _____.
- 2a) This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) _____ is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) ☒ Claims 1-30 are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - a) All b) Some* c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- | | |
|--|---|
| 15) Notice of References Cited (PTO 892) | 18) Interview Summary (PTO 413) Paper No(s) |
| 16) Notice of Draftsperson's Patent Drawing Review (PTO 948) | 19) Notice of Informal Patent Application (PTO 152) |
| 17) Information Disclosure Statement(s) (PTO 1449) Paper No(s) | 20) Other |

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DETAILED ACTION

Election/Restriction

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-11 and 28 drawn to a method for producing *Pasteuria* endospores *in vitro* comprising growing *Pasteuria* in a growth medium and an endospore created from such a process classified in class 435, subclass 252.1 for example.
- II. Claims 12-22, drawn to a method for protecting a plant from infection comprising administration of a 'helper' factor to said plant, classified in class 424, subclass 405 for example.
- III. Claims 23-25 drawn to a method for protecting a plant from infection wherein the 'helper factor' is recombinantly produced, classified in class 435 subclass 69.1 for example.
- IV. Claim 26, drawn to a compound 'HF-1' which facilitates the *in vitro* growth of *Pasteuria*, classified in class 435, subclass 244 for example.
- V. Claim 27, drawn to a biologically pure culture of 'an isolate', classified in class 435, subclass 243 for example.

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The inventions are distinct, each from the other because of the following reasons:

Inventions I -V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case, all of the products claimed, ie; the microorganism, the endospore and the HF-1 are all different, and possess different utilities. The bacteria known as *Pasteuria* are known to create endospores which have a toxic effect on nematodes, which in turn tend to beneficially help plant growth. However, the *Pasteuria* produce endospores, and it is the endospores which have the insecticidal effect. The product disclosed as HF-1 is merely an additive to a medium in which to grow *Pasteuria*, which has nothing in common with the bacteria or the endospores produced therewith. Group III is drawn to where the method comprises a transgenic plant which produces a 'helper factor.' Because the helper factor is recombinantly produced, the helper factor, as well as a method for use thereof are patentably distinct from the natural 'helper factor' and would require additional searches with regard to the non-patented literature.

The method claims of Group II are unrelated to any of the product claims and/or the method claims of Group I. The method of group II simply recites the use of a 'helper factor' which is not mentioned in any other Group, and is therefore unrelated. Because the method for producing an endospore in Group I does not require the particulars of the claims of Group II, the Groups are patentably distinct.

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The search for each of the above inventions is not co-extensive particularly with regard to the non-patent literature search. Further, a reference which would anticipate the invention of one group would not necessarily anticipate or even make obvious another group.

Because these inventions are distinct for the reasons given above and the search required for each Group is not required for the others, restriction for examination purposes as indicated is proper.

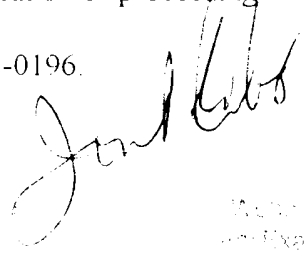
A telephone call was made to David R. Saliwanchick on 11/27/2000 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Patricia Patten, whose telephone number is (703)308-1189. The examiner can normally be reached on M-F from 9am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Wityshyn, can be reached on (703) 308-4743. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.



Patricia Patten
Examiner